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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,628	03/10/2000	Frederic Petit	10655.7500	5109

7590 05/06/2004

Snell and Wilmer LLP  
Suite 1200  
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Irvine, CA 92614-7060

EXAMINER
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ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/522,628

Applicant(s)

PETIT, FREDERIC

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19,27 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19,27 and 34-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
  - Claims 19 and 34 are amended.
  - Claims 19, 27, and 34-36 have been considered.
3. Examiner withdraws rejection of claims 19, 27, and 34-36 under U.S.C. 112 second paragraph in regards to the current amended of the claims.

***Response to Amendment***

4. Applicant's arguments filed 4 February 2004, with respect to claims 19 and 34 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 19, 27, and 34-36 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,923,884 to Patrice Peyret in view of U.S. Patent No. 6,105,008 to Virgil M. Davis.
7. As per claim 19, Peyret clearly teaches a method for an information owner to download software to an information device, over a network, wherein said information device comprises a smart card, and said method comprising the steps of:
  - a) the information owner delegating to a third party, download of said software to the information device; wherein said information device is capable of downloading new instruction, update existing

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instructions, and overwriting existing instructions (See Peyret abstract figures 4, and 8-10 along with associated text and column 3, lines 45-68, column 4, lines 6-15, and column 7, lines 20-68);

8. What is not clearly specified by Peyret, is how the acknowledgment is created by the information device and received and processed by the issuer. However, Davis is clearly explicate in the steps of how data in a smart card can be manipulated and changed as well as creating an acknowledgement of such change and manipulation by the smart card as well as considering the security implications of such acknowledgement (See Davis figure 18A-D and associated text, and column 26, lines 46-56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine concepts of Peyret and Davis to achieve a more secure and reliable method, which would be directly creating an acknowledgment within processor of the smart card itself for such transmission of such a response to successful download.

9. It should additionally be noted that transmission of an acknowledgment from a remote device to an owner of data transmitted via a network to the remote device in order to inform the entity of certain data transmission success is a routine practice in the art. It is done in many different forms, insecure or none-secure manners.

10. As per claim 27, Peyret and Davis disclose all the limitations of claim 19, further; Peyret clearly discloses,

- wherein said software comprises an applet (See Peyret column 10, lines 1-39).

11. As per claim 34, Peyret discloses a system for allowing a smart card issuer to securely delegate to a third party the download of an applet to a smart card over a network, said system comprising:

- b) an external device associated with said third party (See Peyret abstract figures 4, and 8-10 along with associated text and column 3, lines 45-68, column 4, lines 6-15, and column 7, lines 20-68),

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- c) said external device capable of transferring said applet to said smart card (See Peyret abstract figures 4, and 8-10 along with associated text and column 3, lines 45-68, column 4, lines 6-15, and column 7, lines 20-68),
- d) wherein said applet is associated with said issuer and said applet is transferred by said third party as delegated by said information owner, said information device capable of downloading new instruction, update existing instruction, and overwriting existing instructions (See Peyret abstract figures 4, and 8-10 along with associated text and column 3, lines 45-68, column 4, lines 6-15, and column 7, lines 20-68).

12. What is not clearly specified by Peyret is how the acknowledgment is created by the information device and received and processed by the issuer. However, Davis is clearly explicate in the steps of how data in a smart card can be manipulated and changed as well as creating an acknowledgement of such change and manipulation by the smart card as well as considering the security implications of such acknowledgement (See Davis figure 18A-D and associated text, and column 26, lines 46-56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine concepts of Peyret and Davis to achieve a more secure and reliable method, which would be directly creating an acknowledgment within processor of the smart card itself for such transmission of such a response to successful download. It should additionally be noted that transmission of an acknowledgment from a remote device to an owner of data transmitted via a network to the remote device in order to inform the entity of certain data transmission success is a routine practice in the art. It is done in many different form insecure or none-secure manners.

13. As per claims 35 and 36, Peyret and Davis disclose all the limitation of claim 34, further; Peyret is not specific on the issue of what type of security is used.

14. However Davis clearly discloses the specifics of what the applicant claims to be an inventive step mentioned above. It would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine concepts of Peyret and Davis to achieve a more secure and reliable

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method, which would be directly creating an acknowledgment within processor of the smart card itself for such transmission of such a response to successful download.

15. It should additionally be noted that transmission of an acknowledgment from a remote device to an owner of data transmitted via a network to the remote device in order to inform the entity of certain data transmission success is a routine practice in the art. It is done in many different form insecure or none-secure manners.

- acknowledgment process utilizes a symmetrical DES algorithm based on said cryptographic key (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27).
- DES algorithm is a triple-DES algorithm (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27).

16. Moreover it is understood that Peyret and Davis clearly disclose the claimed invention, as discussed above, except for the step of utilizing a symmetrical triple DES encryption algorithm using a public key for verifications. It would have been an obvious step to combine teachings of Peyret and Davis, to provide the step of utilizing a symmetrical triple DES encryption algorithm using a public key for verifications, since applicant has not disclosed that if this method in particular solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Peyret and Davis will perform the invention as claimed by the applicant with any method, means or product to verify the encrypted acknowledgment .

17. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner. It should be noted

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that a reference is to be considered not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969).

**Conclusion**

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

or faxed to:

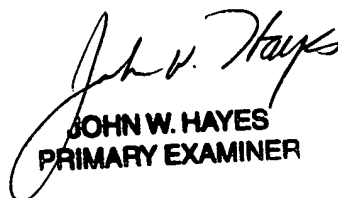
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive  
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K  
April 30, 2004**

  
**JOHN W. HAYES  
PRIMARY EXAMINER**